

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NIKOLAI GRIGORIEVICH LYAPKO

Appeal No. 2006-2049
Application No. 10/031,161
Technology Center 3700

Decided: April 20, 2007

Before TERRY J. OWENS, LINDA E. HORNER, and JOSEPH A. FISCHETTI,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 19-34, which are all of the pending claims.

THE INVENTION

The Appellant claims a device for reflexotherapy (i.e., acupuncture). Claim 19 is illustrative:

1 19. A device for reflexotherapy, comprising:

2
3 an elastic base member being in plasticized condition in the course of
4 heating, and being an integral structure upon curing; and

5
6 needles provided each with one squeezed thickened end and one
7 sharpened end, said squeezed thickened ends being embedded in said elastic
8 base member when in said plasticized condition so that upon curing of said
9 elastic base member at least said squeezed thickened end of each needle is
10 squeezed in said integral structure of said elastic base member, and said
11 remaining sharpened end of each needle protrudes from said integral
12 structure.

13
14 THE REFERENCES

15 Leupold	US 3,923,064	Dec. 2, 1975
16 Gelfer	US 5,250,067	Oct. 5, 1993
17 Yoneda (as translated)	JP 7[1995]-100181	Apr. 18, 1995

18 THE REJECTIONS

19 The claims stand rejected under 35 U.S.C. § 103 as follows: claims 19, 21,
20 23, 27, 29 and 31 over Gelfer in view of Leupold, and claims 20, 22, 24-26, 28, 30
21 and 32-34 over Gelfer in view of Leupold and Yoneda.

22 OPINION

23 The rejections are affirmed as to claims 19, 21, 23, and 25, and reversed as
24 to claims 20, 22, 24, and 26-34. The Appellant does not provide a substantive
25 argument as to the separate patentability of claims 21, 23, and 25 that depend from
26 claim 19, which is the sole independent claim among those claims (Br. 13-21).

27 Therefore, regarding the claims whose rejection is affirmed, we address only
28 claim 19. Claims 21, 23, and 25 fall with claim 19. *See*
29 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Claim 19

Gelfer discloses “an acupuncture treatment device comprising a flexible pad adapted to be pressed against a person’s skin to stimulate blood circulation and safely relieve pain caused by stress, exercise or accident” (Gelfer, col. 1, ll. 9-13). The flexible pad comprises a flexible backing sheet (10) that “can be canvas, or heavy cloth, or a thin sheet of non-woven plastic material” (Gelfer, col. 3, ll. 7-9). In one embodiment one face of the flexible backing sheet has spaced-apart rigid blocks (11) affixed to it (Gelfer, col. 2, ll. 16-19). “Each rigid block has one or more sharp edged protuberances [14, 15] extending away from the sheet so that when the pad is pressed against a person’s skin the sharp edges penetrate or depress the skin to exert an acupuncture effect” (Gelfer, col. 2, ll. 19-23). “The protuberances may be conical in nature, in which case the sharp edges will be defined by the sharpened pointed ends of the conical elements” (Gelfer, col. 2, ll. 23-26; figs. 3, 4). In another embodiment each acupuncture block comprises an elongated, rectangular cross-section bar (19) that is adhesively attached to the flexible backing sheet and has convergent side surfaces (22) extending away from the sheet to form an elongated knife edge (23) (Gelfer, col. 4, ll. 42-48; figs. 5, 6).

Leupold discloses an acupuncture device comprising a plastic holder (1) having the shape of a finger ring (Leupold, col. 2, ll. 60-61). In one embodiment the holder has a flat depression surrounding a preshaped part (8) having a widened flange (9) embedded in the holder and having a dull or rounded tip (7) projecting above the flat depression (Leupold, col. 3, ll. 1-3, 6-10, 14-16; col. 4, ll. 12-13; fig. 3). The holder’s plastic is molded around the embedded widened flange to permanently affix the preshaped part to the plastic holder (Leupold, col. 3, ll. 10-16).

1 The Appellant argues that Gelfer's nonwoven plastic material (Gelfer, col. 3,
2 ll. 8-9) is not disclosed as being elastic (Br. 14-15), and that a flexible article is not
3 necessarily elastic (Reply Br. 3). The dictionary definitions of "elastic" include
4 "capable of being easily stretched or expanded and resuming former shape:
5 FLEXIBLE".¹ Hence, it reasonably appears that Gelfer's disclosure of a plastic
6 material that is flexible (Gelfer, col. 3, ll. 4-9) would have fairly suggested, to one
7 of ordinary skill in the art, a plastic material that is elastic.

8 The Appellant argues that the Appellant's claims recite needles, whereas
9 Gelfer discloses needle-like protuberances (Reply Br. 2). Gelfer discloses that
10 "each protuberance can be a conical needle element" (Abstract). Moreover, the
11 dictionary definitions of "needle" include "a slender pointed object resembling a
12 needle: as (1) : a pointed crystal (2): a sharp rock (3): OBELISK".² Thus, Gelfer's
13 conical needle element reasonably can be considered a needle or, as a minimum,
14 suggestive of a needle.

15 The Appellant argues that Leupold's preshaped part 8 is not a needle and
16 does not have a sharpened end, and that Leopold's holder has a rigid pressure plate
17 (Br. 15-16). That argument is not well taken because the Appellant is attacking the
18 reference individually when the rejection is based on a combination of references.
19 *See In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re*
20 *Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). The Examiner
21 relies upon Gelfer for a disclosure of a needle and an elastic base member
22 (Answer 3).

¹ *Webster's New Collegiate Dictionary* 365 (G. & C. Merriam 1973).

² *Webster's New Collegiate Dictionary*, *supra* note 1, at 768.

1 The Appellant argues that Gelfer's elongated bar 19 is not a needle (Br. 13).
2 As pointed out above, Gelfer's conical needle element either is a needle, or at least
3 would have fairly suggested a needle to one of ordinary skill in the art. Gelfer
4 discloses attaching the elongated bar directly to the flexible backing sheet (Gelfer,
5 col. 4, ll. 45-48; figs. 5, 6), but does not disclose such direct attachment of the
6 conical needle element. Instead, the conical needle element is attached to a rigid
7 block which is attached to the flexible backing sheet (Gelfer, col. 3, ll. 4-7; figs. 3,
8 4). For attachment of the conical needle element directly to the flexible backing
9 sheet to have been *prima facie* obvious to one of ordinary skill in the art, the
10 applied prior art must have provided one of ordinary skill in the art with both a
11 motivation to provide that attachment and a reasonable expectation of success in
12 doing so. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir.
13 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).
14 One of ordinary skill in the art would have been motivated to eliminate the rigid
15 block to eliminate the cost associated with it. *See In re Thompson*, 545 F.2d 1290,
16 1294, 192 USPQ 275, 277 (CCPA 1976); *In re Clinton*, 527 F.2d 1226, 1229, 188
17 USPQ 365, 367 (CCPA 1976). Leupold discloses that embedding in plastic a
18 widened flange at the base of a preshaped acupuncture protuberance as the plastic
19 is molded permanently affixes the protuberance to the plastic (Leupold, col. 3,
20 ll. 10-16). That disclosure would have provided one of ordinary skill in the art
21 with a reasonable expectation of success in permanently affixing Gelfer's conical
22 needle element to the flexible plastic backing sheet by forming a widened flange at
23 the base of that element and embedding the widened flange in the flexible plastic
24 material. Therefore, embedding the base portion of Gelfer's conical needle
25 element in the flexible plastic backing material would have been *prima facie*
26 obvious to one of ordinary skill in the art.

The Appellant argues that the applied prior art does not disclose a squeezed thickened end of a needle (Br. 15). The squeezing is the tight clamping of the thickened end by the base material after the base material has cooled (Specification 9:26-28). Consequently, it reasonably appears when Leupold's plastic is molded around the preshaped part's widened flange (Leupold, col. 3, ll. 10-16), the widened flange likewise is squeezed when the plastic has cooled.

The Appellant argues that “there is no reason given in the final rejection to support the proposed combination [of Gelfer and Leupold], other than the statement ‘it would have been obvious to one skilled in the art to embed the needles having a thickened end head within the base, as taught by Leupold, for the purpose of stabilizing the anchoring of the needles to the base, to thus prevent the needles from breaking off’” (Br. 18). The Examiner’s reason quoted by the Appellant is plausible, and the Appellant has provided no substantive argument as to why it is incorrect.

The Appellant sets forth a laundry list of boilerplate legal arguments (Br. 19-21). Those arguments are not well taken because no substantive reasoning is provided in support of the arguments.

For the above reasons we are not convinced of reversible error in the Examiner's rejection of claim 19 or claims 21, 23, and 25 that fall therewith.

Claims 27-34

Claim 27 requires an elastic base member consisting of two layers, and needles each having a squeezed thickened end disposed between the two layers, joined together with the two layers, and fastened substantially in an area of joint between the two layers.

The Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to select two or more

1 layers of plastic material to form the sheet, with the needles embedded between the
2 layers in the base member, as taught and suggested by Leupold, since it has been
3 held that constructing a formerly integral structure in various elements (layers)
4 involves only routine skill in the art” (Answer 4). For a prima facie case of
5 obviousness to be established, the teachings from the prior art itself must appear to
6 have suggested the claimed subject matter to one of ordinary skill in the art. *See In*
7 *re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). Leupold
8 does not disclose two base member layers, and the Examiner has not explained
9 how the applied references would have fairly suggested, to one of ordinary skill in
10 the art, a two layer base member, let alone the location and fastening of the
11 needle’s squeezed end at the joint between the two layers as required by the
12 Appellant’s claim 27.

13 The Examiner, therefore, has not established a prima facie case of
14 obviousness of the invention claimed in the Appellant’s claim 27 or its dependent
15 claims 28-34.

16 Claims 20, 22, 24, and 26

17 Yoneda discloses an acupuncture device comprising, in one embodiment, a
18 base plate (1) having thereon sharp conical projections (2) that provide an effect
19 analogous to a needle (Yoneda, p. 4, ¶ 0011). In another embodiment a
20 pedestal (13) is attached to a base plate (10), and an intradermal needle (12)
21 projects through a hole in the pedestal and is fixed in place by pressure-sensitive
22 adhesive tape (16) (Yoneda, pp. 5-6, ¶ 0015; fig. 7).

23 The Appellant’s claim 20 depends from claim 19 and requires that “an
24 external surface of said base member is provided with lugs surrounding said
25 needles.”

The Examiner relies upon Yoneda's pedestal as corresponding to the Appellant's lugs, and argues that "it would have been obvious to one skilled in the art to modify the needle of Gelfer/Leupold to have lugs disposed on the base member and surrounding the needles, as taught by Yoneda, for the purpose of providing a lug to serve as stabilizing means that allows for increased retention of the needle" (Answer 5). Yoneda's needle projects through a hole in the pedestal without contacting the portion of the pedestal surrounding the hole, and is held in place by pressure-sensitive adhesive tape (Yoneda, pp. 5-6, ¶ 0015; fig. 8). The pedestal does not appear to stabilize the needle or increase its retention. Moreover, Yoneda does not use the pedestal in the embodiment having a sharp conical projection (2) (Yoneda, p. 4, ¶ 0011; fig. 1) that is similar to Gelfer's conical needle element (Gelfer, figs. 3, 4). Thus, the record indicates that the Examiner's reason for placing Yoneda's pedestal around Gelfer's conical needle element comes from the Appellant's disclosure rather than coming from the applied prior art. The record, therefore, indicates that the Examiner used impermissible hindsight in rejecting the Appellant's claim 20 and its dependent claims 22, 24 and 26. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we conclude that the Examiner has not established a prima facie case of obviousness of the invention claimed in those claims.

DECISION

The rejection under 35 U.S.C. § 103 of claims 19, 21, 23, 27, 29, and 31 over Gelfer in view of Leupold is affirmed as to claims 19, 21, and 23, and reversed as to claims 27, 29, and 31. The rejection under 35 U.S.C. § 103 of claims 20, 22, 24-26, 28, 30, and 32-34 over Gelfer in view of Leupold and

Yoneda is affirmed as to claim 25 and reversed as to claims 20, 22, 24, 26, 28, 30,
and 32-34.

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 C.F.R. § 1.136(a)(2006).

AFFIRMED-IN-PART

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